



Serial No. 10/662,947

REMARKS

In accordance with the foregoing, claims 15-22 are pending and under consideration.

The sole issue raised in the outstanding Office Action is an assertion that the claims are improper because they are directed to a non-elected invention. Applicants respectfully disagree. As described below, it is believed that the subject matter of claims 15-22 is fully appropriate for a reissue application.

The Examiner asserts that the claims are directed to prohibited recapture. The general rules for recapture were established in *In re Clement*, 131 F. 3d 1464, 45 U.S.P.Q 2d 1161 (Fed. Cir. 1997) and *Ball Corp. v. United States*, 729 F. 2d 1429, 221, U.S.P.Q 289 (Fed. Cir. 284).

These cases set forth that:

- Claims narrower in all aspects - No estoppel
- Claims broader in all aspects - Estoppel
- Claims narrower in some aspects and broader in some aspects:
 - Narrowing aspect related to patentability - No estoppel
 - Narrowing aspect not related to patentability - Estoppel

Independent claims 15 and 16 recite that each of the slits has a first region with a first width and a second region with a second width, the first width being less than the second width. According to claims 15 and 16, the springy portion of each contact pin has a width less than the second width. The non-elected claims of the original application made no mention of a springy portion of a contact pin having a width less than a second width. Accordingly, claims 15 and 16 are narrower in this aspect.

As described below, the narrowing aspect is related to patentability. Specifically, in the parent application, a prior art rejection was raised based on U.S. Patent No. 5,713,751 to Fukunaga.

In an Amendment filed on February 12, 2001, the patented claims were distinguished based on the claimed engagement portions, which retain the contact piece. The following is an excerpt of the arguments made on February 12, 2001.

Applicant teaches an IC socket having a contact pin with a movable contact piece and a stationary contact piece to contact upper and lower sides, respectively, of an electrical lead of an electrical part. The stationary contact piece includes an engagement portion that engages a complimentary engagement portion of the socket body. This engagement limits upward movement of the stationary contact part, which could cause deterioration of the

electrical contact with, or deformation of the lead.

For example, as shown in Figure 2, the stationary contacting piece (15e) includes an engagement portion (15g) to engage with an engaging portion (19d) of the seating plate (19) of the socket body.

Fukunaga does not disclose an engagement portion in either the socket body (12) or the stationary contact piece (15G) of the contact pin that would prevent upward movement of the stationary contact piece (See Figures 8A, 8B, 9A, 9B, and 12).

The second embodiment has somewhat different engagement portions from the first embodiment. In the second embodiment, the contact pins 25 are received within slits 23d (see Fig. 11) provided in the socket body 23. The upper slit portion 23e is narrower than the lower slit portion 23f. See column 9, lines 11-23 of the patent. Referring to Fig. 9, the springy portion 25c of the contact pin 25 is narrower than the lower slit portion 23f. The varying widths (23e narrower than 25c) retain the contact pin 25 within the socket body 23 in a similar matter as the engagement portions retain the contact pin of the first embodiment. This feature was not claimed in cancelled claims 5-7. The narrowing aspect of the claims, the springy portion having a width less than the second width, relates to patentability (the Fukunaga prior art rejection). The case law is clear that if the claims are narrower and in aspect related to patentability, estoppel does not apply. Therefore, the recapture rejection should be withdrawn, at least as it concerns claims 15 and 16.

With regard to claims 17-20, these claims are directed to a mounted electrical part. The original application did not contain claims directed to a mounted electrical part. Clearly a mounted electrical part is different from a socket. The election requirement was not directed to this invention, and accordingly, the recapture rejection should not apply to claims 17-20.

With regard to claims 21 and 22, these claims are directed to a method of mounting an electrical part. 35 U.S.C. § 101 states whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof may obtain a patent therefore. Section 101 defines the different categories of patentable subject matter. Processes are clearly separated from machines and manufactures. The original application contained no claims directed to the process class of statutory subject matter. It is submitted that had the original application contained claims 21 and 22, the Examiner would have restricted claims 21 and 22 from non-elected claims 5-7. It is well established that reissue can be used to pursue protection directed to another class of statutory subject matter if the

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application did not contain claims directed such other class. Claims 21 and 22 are to achieve this completely legitimate purpose. Accordingly, the recapture rejection should be withdrawn with regard to these claims.

Applicants respectfully request that the recapture objection be withdrawn. There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

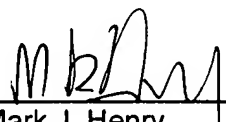
Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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